IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

RICHARD G. HYATT Jr.

Serial No.:	08/720,070	Examiner:	BARRETT, SUZANNE
Filed:	27 September 1996	Art Unit:	3653
For:	ELECTROMECHANICAL CYLINDER PLUG		

REQUEST FOR RECONSIDERATION

Mail Stop: Box Fee **Paper No. 84**
Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

In response to a **third** Notification of Non-Compliant Appeal Brief (37 CFR 41.37) (Paper No. 08042005) mailed on 5 August 2005, Applicant respectfully requests reconsideration of the ground averred in the **third** Notification of Non-Compliant Appeal Brief, and as reasons therefor, states that:

Folio: P53821C
Date: 12/5/05
I.D.: REB/kf

STATEMENT OF FACTS

1. On 13 June 2003, a Final Office action (Paper No. 53) was issued, which stated that:

   i) Of all pending Claims 1-56, 64-116, and 119-121, claims 43-45, 73, and 94 are withdrawn from further consideration pursuant to 37 CFR 1,142(b).

   ii) Claims 25-33, 39-42, 55, 78-84, and 107 are allowed.

   iii) Claims 11-13, 90, and 120 are rejected under 35 U.S.C. 112, first paragraph..

   iv) Claims 1-5, 6-10, 14-24, 35-38, 70-74, 106, 111, 121 are rejected under 35 U.S.C.112, second paragraph.

   v) Claims 1-5, 11-13, 34, 65-69, 75, 85, 89, 92-104, 112, 121 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-78 of U.S. Patent No. 6,564,601.

   vi) Claims 46-52, 54, 56, 64, 70, 76, 77, 85, 88-91, 105, 108, 109, 111, 113-116, 119, 120, and 121 as best understood, are rejected under 35 U.S.C.103(a) as being unpatentable over Gokcebay, U.S. Patent No. 5,552,777 in view of Thordmark *et al.,* U.S. Patent No. 5,542,274 and Naveda, U.S. Patent No. 4,416,127.

2. On 14 June 2003, Applicant file a written Response (Paper No. 54) in reply to the final Office action (Paper dNo. 53). No claim amendments were made.

3. On 30 July 2003, Applicant filed a Supplemental Response.

4. 3 October 2003, an Advisory Action (Paper No. 56) was issued in response to the 20 July 2003 Response (Paper No. 55). The Examiner stated that: "[t]he request for reconsideration has been considered but

does NOT place the application in condition for allowance because Applicant has failed to argue or mention the rejections set forth in the final office action of 6/13/03. Furthermore, applicant's discussion of claims 85-88 is erroneous and moot, since these are not the claims that have been filed in the DIV 10/440,308. In addition, it is unclear why applicant has instructed the examiner to disregard the response of 7/14/03 (the 1.607(a) analysis) since this is necessary to proceed to Interference and it has not also been filed in the DIV 10/440,308 case."

5. On 3 December 2003, a Notice of Appeal (Paper no. 58) was filed together with a Petition for a two-month extension of time (Paper No. 57).

6. On 3 June 2004, a **first** Appeal Brief (Paper no. 61) was filed together with a **first** Amendment under 37 C.F.R. §1.116(b) (Paper No. 62) and a Petition for a four-month extension of time (Paper No. 60). In the Amendment (Paper No. 62), claims 85 through 89 are canceled without prejudice or disclaimer, Claims 1, 6, 11, 14, 21 through 24, 65, 70, 75, 92, 101, 102, and 121 are amended. Thus claims 1 through 56, 64 through 84, 90 through116, and 119 through 121 would be pending upon entry of Paper No. 62.

7. On 17 September 2004, an Advisory Action (Paper No. 09152004) was issued. The Examiner stated the reasons for not entering the Amendment filed on 3 June 2004 that, (a) they raise new issues that would require further consideration and/or search, and (b) they are not deemed to place the application in better form for appeal by materially reducing or

simplifying the issues for appeal. In addition, the Examiner stated that "while the amendments to claims 1, 6, 11, 70 merely correct minor errors and would be entered if filed separately, the amendments to claim 14, 21-24, 65, 75, 92, 101, 102, 121 present broadened or narrowed terms and new issues which change the scope of the claims and would require further consideration."

8. On 17 September 2004, a Notification of Non-Compliance With 37 CFR 1.192(c) (Paper No. 09152004) was issued. The Examiner stated the reasons for non-compliance is that:

- The Appeal Brief filed on 3 June 2004 is defective for failure to comply with one or more provisions of 37 CFR § 1.192(c). See MPEP § 1206.
- The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
- At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
- The brief includes the statement required by 37 CFR 1.192 (c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
- The brief does not present and argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
- The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).

- Other (including any explanation in support of the above items): This is in response to the appeal brief filed 3 June 2004. The appeal brief is defective for the following reasons:

- Status of Claims: The statement of the status of the claims contained in the brief is incorrect. Since the amendment filed 3 June 2004 has not been entered, the reference to claims 85-89 being cancelled should be deleted.

- Status of Amendments After Final: The appellant's statement fo the status of amendments after final rejection contained in the brief in incorrect. The amendment after final rejection field on 3 June 2004 has not been entered. Accordingly, Appendix II, listing the claims as amended by the amendment of 3 June 2004, should be deleted.

- Grouping of Claims: The appellant's statement in the brief that each claim stands or falls individually is inconsistent with Appellant's arguments. If each claim stands alone, then each claim must be separately argued. In the instant brief, each claim is not argued separately. It is noted that all claims are listed in the headings of each separate argument, however, the body of the arguments do not discuss each claim separately. For example, no separate argument could be found for independent claim 101, although it is listed in the argument heading on page 9.

- Claims Appealed: A correct copy of appealed claims appears in Appendix I attached to the brief, however, as noted above, Appendix II should be deleted since the amendment filed 3 June 2004 has not been entered.

- Response to Argument: On page 16 of the Appeal Brief, line 4, Appellant argues "Claims ... 120 and 120 ... " it is unclear which claim Appellant intends to argue. Additionally, Appellant should make sure that the arguments presented in the brief do not reflect the amendments presented in the amendment after final submitted 3 June 2004 which has not been entered.

9. On 24 September 2004, **Second Amendment Under 37 CFR § 1.116(b)** was filed in response to, and in conformance with the Examiner's

statements set forth in the Advisory Action (Paper No.09152004) dated 22 September 2004. Claims 1, 6, 11, 14, 21 through 24, 65, 70, 75, 92, 101, 102, and 121 were amended.

10. On 18 October 2004, a Corrected **(Second)** Appeal Brief (Paper No. 70) was filed in response to Paper No. 09152004 dated 17 September 2004, together with a **Third Amendment Under 37 CFR § 1.116(b)** which was filed in further response to Paper No. 09152004 dated on 22 September 2004, and alternative to the **Second Amendment** filed on 24 September 2004.

11. On 25 October 2004, a **Third Appeal Brief** (Paper No. 71) was filed together with a **Fourth Amendment Under 37 CFR § 1.116(b) (Part I)** and **Fourth Amendment Under 37 CFR § 1.116(b) (Part II). Part I** requesting cancellation of claims 85 through 89 and 101 through 104, and amendment of claims 1, 6, 11, 14 and 70, while **Part II** requesting amendment of claims 56, 75 and 120.

12. On 18 November 2004, a third Advisory Action (Paper No. 11162004) was issued in response to the Amendments filed on 25 October 2004, which stated in part, for purposes of Appeal, the proposed amendments will be entered. The status of the claim(s) is (or will be) as follows: Claim(s) allowed: 25-33, 39-42, 55, 78-84, 107; Claim(s) objected to: 53, 71, 72, 74,

and 110; Claim(s) rejected: 1-24, 34-38, 46-52, 54, 56, 64-70, 75, 77, 90-93, 95-100, 105, 106, 108, 109, 111-116, and 119-121.

13. On 17 March 2005, a **second** Notification of Non-Compliant Appeal Brief (37 CFR 41.37) (Paper No. 03162005) was issued, which stated:

- The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
- At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
- The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1)identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) se forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
- The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37 (c)(1)(vii)).
- Status of Claims: The statement of the status of the claims contained in the brief is incorrect. Since the amendment filed 25 October 2004 will be entered for purposes of appeal (advisory action of 17 November 2004), the reference to claims 85-89, 101-104 should be deleted in the brief and labeled accordingly in the appendix.
- Status of Amendments After Final: The appellant's statement of the status of amendments after final rejection contained in the brief is in correct. The amendment after final filed 25 October 2004 will be entered for purposes of appeal (advisory action on 17 November 2004).

- Grouping of the Claims: The appellant's statement in the brief that each claim stands or falls individually is inconsistent with appellant's arguments. If each claim stands alone, then each claim must be argues separately. In the instant brief, each claims not argued separately. It is noted that claims 47-52, 54 and 121 are not argued at all. Furthermore, it is unclear whether appellant is abiding by the old rules or the new rules. Appellant has included the section for "grouping of the claims" (old rules - in which each claim must then be argued separately.), yet the arguments are presented according to the new rules (i.e. not separately argued, but merely grouped into headings). Under the new rules, only the argument heading must include all the claims, but the body of the argument may set forth only one claim, in which case, the rest of the unargued claims stand or fall with the argued claim. For example, while claim 46 is argued in the brief, claims 47-52 are not, thus under the new rules, the appeal would not be defective in this regard, but claims 47-52 would stand or fall with claim 46. Since appellant has specifically indicated in his grouping that the claims do not stand or fall together, this is confusing and, consequently, the appeal is held to be defective in that claims 47-52 are not argued separately. Accordingly, it is unclear if claims 47-52, 54, and 121 should stand or fall with other claims or not.

- Argument:

  The appellant has failed to address or argue the grounds of rejection under 35 USC 112, 2nd paragraph with respect to claims 14 and 121. Accordingly, it is unclear if appellant is acquiescing to these rejections.

  Furthermore, appellant has presented argument with respect to claims 85-89, 101-104, which have been cancelled by the amendment of 25 October 2004. These arguments should be deleted from the brief.

  In addition, appellant has presented 18 pages of conclusory arguments wherein some claims are further specifically addressed. It is unclear why these arguments pertaining to specific claims are not presented in the pertinent individual claim argument subsections throughout the brief.

14. On 14 April 2005, a **Fourth Appeal Brief** (Paper No. 77) was filed with a **Fifth Amendment Under 37 CFR § 1.116(b)**, amending claim 14.

15. On 5 August 2005, Advisory Action After the Filing of an Appeal Brief (Paper No. 080405) was issued in response to the "reply filed 20 April 2005 and 10/25/04". The Examiner states that the amendments will not be entered because "the amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c)."

16. On 5 August 2005, a **third** Notification of a Non-Compliant Appeal Brief under 37 CFR 41.37 (Paper No. 08042005) was issued in response to the Fourth Appeal Brief filed on 18 April 2005. The reasons given for non-compliance Paper No. 08042005 are as follows:

i) The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37 (c)(1)(iii);

ii) At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37 (c)(1)(iv);

iii) (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal,

referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37 (c)(1)(v));

iv) The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37 (c)(1)(viii));

v) The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37 (c)(1)(ix));

vi) The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences § of the brief as an appendix thereto (37 CFR 41.37 (c)(1)(x));

In addition, the Examiner stated the following as reasons for non-compliance:

> Defective Brief Notice:
>
> Initially, it is noted that the amendment filed 25 October 2004, previously indicated as being entered upon appeal, are not entered pursuant Rule 41.33(b). Accordingly, the amendment filed 20 April 2005, simultaneously with this brief, is also not entered.
>
> Consequently, the claims previsouly cancelled (85-89, 101-104) must be reinstated and the typos and 112 problems corrected by the amendment of 25 October 2004 must now be addressed in Appellant's brief where indicated.
>
> In addition, it is noted that since the amendment to claim 6 deleted a "means" limitation, and since that "means" language is now reinstated, it must be clearly and specifically discussed in the Summary of the Claimed Invention as indicated in the rule excerpt set forth in paragraph 4(b) of the accompanying Notification of Non-Compliant Appeal Brief (form PTOL-462).
>
> Renege on entry of after-final amendments filed on or after 13 September 2004 as outside the scope of examiner's authority - See 41.33(b).
>
> The Brief is defective under 41.37(a)(2).
>
> This is in response to the appeal brief filed 20 April 2005.

- Grouping of the Claims: This section is no longer required under new rules and should be deleted.
- Heading Grouping of the Claims was required by former Rule 192(c)(7) and is removed from 41.37. See 69 Fed. Reg. 49959, 49962.

Status of Claims:

- The statement of the status of the claims contained in the brief is incorrect.
- Since the amendment filed 25 October 2004 and 20 April 2005 will not be entered for purposes of appeal. The reference to claims 85-89, 101-104 should be reinstated in the brief and the appendix and the previously amended claims 1, 6, 11, 14, 56, 70, 75, 120 should be reinstated to their pre-amendment form. Therefore, the status of the claims would be as follows:

Claims 1-56, 64-116, 119-121 are pending.

Claims 25-33, 39*-42, 55, 78-84, 107 are allowed.

Claims 53, 71, 72, 74, 86, 87, 110 are objected to as dependent upon a rejection claim.

Claims 1-24, 34-38, 46-52, 54, 56, 64-70, 75-77, 85, 88-106, 108, 109, 11-116, 119-121 are rejected.

Claims 43-45, 73, 94 are withdrawn from

consideration.

Claims 57-63, 117, 118 have been cancelled.

- Status of Amendments After Final:

- The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

- The amendments after final filed 25 October 2004 and 20 April 2005 will not be entered for purposes of appeal.

- Although the amendment filed 25 October 2004 had previously been indicated as entered upon appeal, this is contrary to Rule 41.33(b) as discussed above.

- Thus the status of the amendment should read that the amendments filed 25 October 2004 and 20 April 2005 have not been entered.

- Summary of the Claimed Invention:

- Deficiencies under 41.37(c)./41.37(c)(1)(v)

I: (1) Appellant has provided only a general statement of

the claimed invention.

(2) See Comment 53 of 69 Fed. Reg. 49959.

II: (1) Accordingly, since the "means" language of claim 6 (previously deleted in the amendment of 25 October 2004) is reinstated, this "means" limitation must be identified and discussed pursuant the rule set forth above.

Argument Notes:

- (1) 41.379c)(1)(vii) is not defective but appellant groups some claims with rejections that do not apply to such claims.

- Claims 14 (allowed but rejected under 35 USC 112) and 43 (withdrawn) are argued under the prior art grounds of rejection on pages 31-33; claims 65 and 75 are argued with respect to the prior art rejections on pages 41-47, when both claims are only rejected under double patenting.

- (2) The appellant has failed to address or argue the grounds of rejection under 35 USC 112, 2nd paragraph with respect to claims 14 and 121. Accordingly, it is unclear if appellant is acquiescing to these rejections.

- (3) In addition, appellant has presented 18 pages of conclusory arguments

wherein some claims are further specifically addressed. It is unclear why these arguments pertaining to specific claims are not presented in the pertinent individual claim argument subsections throughout the brief.

- Claim Appendix:

  The brief does not contain a correct copy of the appealed claims as an appendix thereto. (37 CFR 41.37(c)(1)(viii).

- 41.37(c)(1)(viii) is defective since appellant provided two copies. Only one correct copy should be provided.

- Furthermore, Appellant should carefully revise his appendix to reinstate the previously entered amended claims 1, 6, 11, 14, 56, 70, 75, 120 to their pre-amendment form in the appendix.

Evidence Appendix:

- The brief does not contain copies of any evidence submitted. If no evidence has been submitted, "none" should be type don that appendix page.

Related Proceedings Appendix:

- The brief does not contain copies of any decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto. If no related proceedings exist, "none" should be typed on that appendix page.

- 41.37(c)(1)(ix) and (x) are missing. See comment 60, 69 Fed. Reg. 49959, 49978.

Interview Summary:

2 August 2005 by telephonic: Mr. Bushnell was informed that the appeal brief filed 20 April 2005 appeared to be defective, that the Evidence Appendix and Related Proceedings Appendix are missing and the Summary of the Claimed invention does not comply with 41.37(c)(1)(v) and also, that the amendment filed 20 April 2005 would not ben entered. He was also informed that the entrance of the amendments filed 25 October 2004 was erroneous under the new rules and thus the exr is forced to renege on their entry. Mr. Bushnell indicated that there was no evidence or related proceedings to disclose.

17. Throughout the prosecution of this appeal, Appellant has never acquiesced in the accuracy or propriety of any of the averments set forth in any Notification of a Non-Compliant Appeal Brief, and has instead simply sought to comply with 37 CFR §1.192(c) without ignoring the preferences of the Board of Patent Appeals and Interferences articulated in 37 CFR §41.37, with the understanding that the requirements of 37 CFR §1.192 governed in accordance with the guidelines offered by the Director's statement that, "an amended Appeal Brief, based on an Appeal Brief originally filed prior to September 13, 2004, would be acceptable if it

complies with either former §1.192 or §41.37(c), and internal Board *regardless of* when the Office mailed the Notice requiring correction of Non-Compliant Appeal Brief."[1]

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[1] *Official Gazette Notices*: 12 October 2004, Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule).

REMARKS

In view of successive allegations of *Non-Compliant Appeal Brief* by the Special Program Examiners of Tech Center 3676, Applicant respectfully requests reconsideration by the Director pursuant to 37 C.F.R. § 1.181(a)(1) from the action in requirements set forth at the direction of the Special Programer Shop of Tech Center 3676 (SPrE shop) by the Examiner in the Notice of Non-Compliant Appeal Brief issued on the 8th of August 2005 (Paper No. 08042005) and pursuant to 37 C.F.R. §1.181(a)(3) to invoke the Supervisory of Authority of the Director, and to direct entry of Applicant's Fourth Appeal Brief (Paper No. 77) timely filed on the 18th of April 2005, in view of the foregoing statement of facts.

1. Statement of Status of All Claims

In paragraph 2 of Paper No. 08042005, the Examiner asserts that Applicant's brief Statement of status of all claims pursuant to 37 C.F.R. §41.37(c)(1)(iii). In essence, the Examiner denies entry of Applicant's Appeal Brief as failing to comply with the amended rules even though Applicant's Notice of Appeal was filed on the 3rd of December 2003 prior to the adoption of the amended rules, and denies entry of Applicant's Fourth Appeal Brief on grounds that the appendicies do not set forth the allowed and the cancelled claims even though Applicant's Notice of Appeal was filed on the 3rd of December 2003 and the first Appeal Brief was subsequently filed on the 3rd of June 2004, long prior to the 13th of September 2004 effective date of the amended rules. Moreover, Applicant's Second, Third, and Fourth Appeal Briefs were filed in response to actions taken by the Examiner and were not filed as a "restatement"of an earlier Appeal. As explained in the

Notice published in the *Official Gazette* on the 12th of October 2004 entitled "clarification of the effective date provision in rules are practiced before the Board Patent Appeal and Interferences," in answer to question No. 6,

> "If a brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of Sec. 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with Sec. 41.37(c)?"

The Director answered:

> "No, an amended Appeal Brief, based on an Appeal Brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former §1.192 or §41.37(c), and internal Board *regardless of* when the Office mailed the Notice requiring correction of Non-Compliant Appeal Brief."[2]

Consequently, Applicant's series of Appeal Briefs are all clearly acceptable under 37 C.F.R. §1.192 and there is no need for the Examiner to insist upon the filing of yet a fifth Appeal Brief complying strictly with the interpretations of the amended rules recently created by the Special Program Examiners of Tech Center 3600.

2. At least one Amendment has been filed subsequent to the Final Rejection.

Paragraph 3 of Paper No. 08042005 avers that "at least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of **each such** amendment." Neither 37 CFR §1.192(c)(4) nor 37 CFR

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[2] *Official Gazette Notices*: 12 October 2004, Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule).

§41.37(c)(1)(iii) impose this requirement; both sections speak in terms of "**any** amendment filed subsequent to the final rejection." Customarily, this phrase "any amendment filed" has been applied to a determination of the contents of an appeal brief by requiring the appellant to list the dates and substance of those amendments which affect the issues before the Board, and the status of those amendment in terms of whether the amendment had been entered or had not yet been considered by the Examiner at the time of filing of the Appeal or Reply Brief; this phrase has never been applied to impose a mandatory listing of **all** amendments filed subsequent to the final rejection, or those amendments under 37 CFR §1.116(b) which the Examiner had, prior to the filing of the appeal or reply brief, said had not been entered and which did not affect the merits of the issues pending before the Board. Had the Director required **all** amendments to be listed, the either 37 CFR §1.192(c)(4) or 37 CFR §41.37(c)(1)(iii), either or both sections would read "~~**any**~~ all ~~amendment~~ amendments filed subsequent to the final rejection." The fact that both 37 CFR §1.192(c)(4) and CFR §41.37(c)(1)(iii) are identical in their wording means that the most recent amendments of the rules of appellate practice did not change either the interpretation of the rules or the customarily practice under those rules. As indicated in the foregoing statement of facts, all of Applicant's several briefs are in compliance with both 37 CFR §1.192(c)(4) or 37 CFR §41.37(c)(1)(iii), and this averment of "non-compliance" should not be sustained.

3. Concise Explanation Of The Subject Matter Defined In Each Independent Claim

In paragraph 4, the Special Program Examiners required the Examiner to write that:

> "(a) [t]he brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v))."

This averment is both factually incorrect and legally wrong.

First, 37 CFR 41.37(c)(1)(v) contains two discrete sentences, the second sentence pertains solely to "means plus function claims"; in this application, the appealed claims do not contain "means plus function" language;[3] consequently, the second half of this averment about Applicant's Appeal Briefs is inapplicable, and may not be used as a basis to sustain the Examiner's demand for filing a corrected appeal brief.

Second, the Director has already clarified the amended rules by explaining that:

> "an amended Appeal Brief, based on an Appeal Brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former §1.192 or §41.37(c), *regardless of* when the Office mailed the Notice requiring correction of Non-Compliant Appeal Brief."[4]

Consequently, Applicant's series of Appeal Briefs are all clearly acceptable under 37

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[3] Contrary to the Special Program Examiner's assertion, claim 6 does not contain "means plus function" language, and Applicant has not proposed to amend claim 6 in the amendment filed on the 18th of April 2005.

[4] *Official Gazette Notices*: 12 October 2004, Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule).

C.F.R. §1.192 and there is no need for the Examiner to insist upon the filing of yet one more Appeal Brief complying strictly with the interpretations of the amended rules recently created by the Special Program Examiners of Tech Center 3600.

Third, applicant's Appeal Brief does in fact, contain an extensive section entitled *V. SUMMARY OF CLAIMED SUBJECT MATTER* which begins on page 5 and continues through page 8, which presents in detail, in conformance with both 37 CFR §1.192(c)(5) and 37 CFR §41.37(c)(1)(v), "a concise explanation of the subject matter defined in each of the independent claims involved in the appeal," and that detailed explanation is written by "referring to the specification by page and line number and to the drawings ... by reference characters." This concise explanation is specific to each, as well as to all, of the independent claims on appeal. Accordingly, this averment provides no justification for finding Applicant's Appeal Brief to be "non-compliant" with either 37 CFR §1.192(c)(5) or with 37 CFR §41.37(c)(1)(v).

4. Correct Copy Of The Appealed Claims

Paragraph 7 asserts that the appendix does not contain a correct copy of the appealed claims in compliance with 37 CFR §41.37(c)(1)(viii). This is incorrect.

First, each of Applicant's Appeal Briefs contain two appendicies, as is customary when an amendment of the claims accompanies the Appeal Brief. Regardless of whether any of those amendment were, or were not entered, one of those appendicies accompanying each Appeal Brief is a correct copy of the appealed claims.

Second, the Director has already clarified the amended rules by explaining that:

"an amended Appeal Brief, based on an Appeal Brief

> originally filed prior to September 13, 2004, would be acceptable if it complies with either former §1.192 or §41.37(c), and internal Board *regardless of* when the Office mailed the Notice requiring correction of Non-Compliant Appeal Brief."[5]

Consequently, Applicant's series of Appeal Briefs have all clearly acceptable under 37 C.F.R. §1.192 and there is no need for the Examiner to insist upon the Applicant having to file yet one more Appeal Brief complying strictly with the interpretations of the amended rules recently created by the Special Program Examiners of Tech Center 3600.

5. Copies Of Evidence Submitted

Paragraph 8 avers that the Appeal Brief "does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon the appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto, in conformance with 37 CFR §41.37(c)(1)(ix). This averment is also factually incorrect and illegal.

First, Applicant has demonstrated in his Appeal Brief extensive deficiencies in the Examiner's understanding and application of 35 U.S.C. §103(a), including the failure of the proposed combination of art relied upon by the Examiner to make a *prima facie* showing of obviousness *vel non*. This is all the evidence that the Board has ever required, and the amended appellate rules do not impose a requirement for more. Moreover, these

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[5] *Official Gazette Notices*: 12 October 2004, Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule).

errors and deficiencies are present on the face of the final Office action. Applicant has not, contrary to the inference by the Special Program Examiner, submitted evidence under 37 CFR §§1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon the appellant in the appeal. In short, there is no evidence which had been submitted by the Applicant under 37 CFR §§1.130, 1.131, or 1.132 or any other evidence entered by the examiner and relied upon the appellant in the appeal; similarly, there is no basis for submitting in the Appeal Brief "a statement setting forth where in the record that evidence was entered by the examiner" as is required by 37 CFR §41.37(c)(1)(ix), because no passage or interpretation of 37 CFR §41.37(c)(1)(ix) makes such an appendix necessary in the absence of such "evidence"under 37 CFR §§1.130, 1.131 and 1.132 in the prosecution history before the Board. In short, where there has never been any "evidence" submitted under either under 37 CFR §§1.130, 1.131, or 1.132, no passage or interpretation of 37 CFR §41.37(c)(1)(ix) makes an appendix of evidence necessary.

Second, the Director has already clarified the amended rules by explaining that:

> "an amended Appeal Brief, based on an Appeal Brief originally filed prior to September 13, 2004, would be acceptable if it complies with *either* former §1.192 or §41.37(c), and internal Board *regardless of* when the Office mailed the Notice requiring correction of Non-Compliant Appeal Brief."[6]

Consequently, Applicant's series of Appeal Briefs have all clearly acceptable under 37 C.F.R. §1.192 and there is no need for the Examiner to insist upon the Applicant having to file a fifth Appeal Brief complying strictly with an unusual interpretation of the

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amended rules created by the Special Program Examiners of Tech Center 3600.

6. Copies Of Decisions Rendered

Paragraph 9 avers that the Appeal Brief "does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto" 37 CFR §41.37(c)(1)(x). This averment is also factually incorrect and illegal.

First, as earlier noted herein, Applicant has demonstrated in his Appeal Brief extensive deficiencies in the Examiner's understand and application of 35 U.S.C. §103(a), including the failure of the proposed combination of art relied upon by the Examiner to make a *prima facie* showing of obviousness *vel non*. This is all that the Board has ever required, and the amended rules do not impose a requirement for more. Moreover, these errors and deficiencies are readily apparent on the face of the final Office action. Applicant has not, contrary to the inference by the Special Program Examiner, submitted ever received decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto" for the reason that the related appeal has been answered by this Examiner only under the guise of a "*Notification of Non-Compliant Appeal Brief*", rather than with an *Examiner's Answer*. In other words, the related appeal has never been docketed and has never been seen by either the Clerk of the Board or by any panel of the Board. There is therefore, no basis for the Special Program Examiner's demand for an appendix under 37 CFR §41.37(c)(1)(x), because no passage or interpretation of 37 CFR §41.37(c)(1)(ix) makes such an appendix necessary in the absence of such "decision" in

the prosecution history before the Board.

Second, the Director has already clarified the amended rules by explaining that:

> "an amended Appeal Brief, based on an Appeal Brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former §1.192 or §41.37(c), and internal Board *regardless of* when the Office mailed the Notice requiring correction of Non-Compliant Appeal Brief."[7]

Consequently, Applicant's series of Appeal Briefs have all clearly acceptable under 37 C.F.R. §1.192 and there is no need for the Examiner to insist upon the Applicant having to file a fifth Appeal Brief complying strictly with an unusual interpretation of the amended rules created by the Special Program Examiners of Tech Center 3600.

7. 37 CFR §41.1(b) -- Policy.

The various interpretations of the amended appellate rules by the Special Program Examiners rides roughshod over the threshold admonition of the amended rules that,

> "The provisions of Part 41 ***shall*** be construed to secure the just, speedy, and inexpensive resolution of every proceeding before the Board."[8]

To the extent that the most recent *Notification of Non-Compliant Appeal Brief* is premised upon a belated and retraction of an Examiner's entry of an amendment filed pursuant to 37 CFR §1.116(b), Applicant notes that amendments to those claims affected

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[7] *Official Gazette Notices*: 12 October 2004, Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule).

[8] 37 CFR §41.1(b) -- Policy.

were submitted pursuant to 37 CFR §116(b) prior to the amendment of the appellate rules, and in one fashion, or another, were entered in a rather piecemeal fashion subsequently in compliance with the Examiner's predilections over which Applicant has no control. Applicant's Fourth Appeal Brief was prepared and filed in reliance upon the entry of the earlier of those amendments. To invoke at this stage of the appellate process a policy of revocation of a previous affirmation of entry of any one of those amendments denies to Applicant the policy of the amended rules, namely "to secure" to the Applicant a "just, speedy, and inexpensive resolution of every proceeding before the Board"[9], regardless of which set of appellate practice rules are being applied.

Additionally, the repeated practice of the Special Program Examiner in questioning compliance with the recently amended appellate rules is unjustified under the guidelines published by the Director for interpreting those rules,

> "an amended Appeal Brief, based on an Appeal Brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former §1.192 or §41.37(c), and internal Board *regardless of* when the Office mailed the Notice requiring correction of Non-Compliant Appeal Brief".[10]

The flurry of Notices of non-compliance precipitated by (*i*) non-entry, or alternately (*ii*) delayed entry, and now, (*iii*) withdrawal of entry of amendments made after final is unjustified where the Brief contains alternative appendicies of claims, and the original appeal brief was filed long prior to the conception of the amended rule. The practice of

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9 37 CFR §41.1(b) -- Policy.

10 *Official Gazette Notices*: 12 October 2004, Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule).

the Special Program Examiner in questioning the content and extent of Appellant's arguments is contrary to both the former and the amended rules: no rule has ever required an appellant to individually and separately argue each claim appealed; the practice of the Board has long been, and continues to be the consideration of a representative independent claim. The second sentence of 37 CFR §41.37(c)(1)(vii) expressly allocates this option to the Appellant; exercise of this option does not render a Brief non-compliant under either the former rules or under the amended rule.

This retroactive implementation of 37 CFR §41.33(c) to justify the withdrawal of an amendment which was previously entered by the Examiner raises other practice questions of when is an applicant justified in relying upon a written confirmation from a primary examiner, or should clarification be sought from a supervisory primary examiner to confirm the entry of an amendment by a primary examiner in future practice? Here, Appellant filed a fourth Appeal Brief in reliance upon entry of earlier filed amendments. This untimely retraction of entry of an amendment is inimical to speedy and inexpensive completion of a protracted prosecution.

Applicant therefore respectfully requests that the Director will strike the *Notification of Non-Compliant Appeal Brief.* The recent practice of some tech Centers in the Office of refusing to enter an Appeal Brief, although rare, is prohibitively expensive to Applicants, with the result that the individual inventors become discouraged and withdrawal from all patent prosecution; this result is unwarranted, and is not justified by the authority granted by Congress. Moreover, in the experience of Applicant's undersigned attorney, the Board has never requested any of the items noted in the *Notification* in the instant application, and has never remanded an appeal for any of the

averred deficiencies in the Appeal Brief. With the simplicity of the issues under 35 U.S.C. §103(a) present in this appeal, there is no reason to artificially encumber the appeal process with hyper-technical application of the amended rules, particularly where, as here, Applicant initially filed an Appeal Brief and amendments under 37 CFR §1.116(b) well prior to the effective dates of the amended appellant rules, and Applicant has, in good faith, and in reliance upon the written statements of the Examining Corps, endeavored to comply with the numerous items of correspondence over the several years during which this appeal has been pending. The Director is therefor, urged to exercise supervisory authority and permit the Board to complete this appeal without further delay or prejudice to the Applicant.

RELIEF REQUESTED

In view of the above, the Director is respectfully requested to:

A. Refuse to sustain and withdraw each *Notification of Non-Compliant Appeal Brief*;

B. Refuse to sustain the belated withdrawal of an express entry of each amendment of the claims which the Examiner has previously confirmed to have been entered;

C. Confirm that the statement made in Paper No. 11162004 dated on the 18th of November 2004 that Applicant's amendment filed on or about the 25th of October 2004 has in fact been entered into the prosecution history, was correct;

D. Confirm that the statement made in Paper No. 03162005 dated on the 17th of March 2005 that Applicant's amendment filed on or about the 25th of October 2004 has in fact been entered into the prosecution history, was correct;

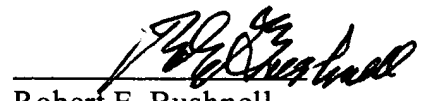
E. Confirm that Paper No. 08042005 dated on the 5th of August 2005 incorrectly applied the criterion set forth in 37 CFR §41.33 rather than the criteria of 37 CFR §1.116(b) to deny entry to Applicant's amendment filed on or about the 20th of April 2005;

F. Enter Applicant's Fourth Appeal Brief filed on or about the 20th of April 2005;

G. Direct the Examiner to prepare and immediately issue an *Examiner's Answer*; and

H. Grant such other and further relief as justice may require.

Respectfully submitted,



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